

### **REMARKS**

This responds to the Office Action mailed on June 25, 2008.

Claims 1, 5, 12, 14, 16 are amended, no claims are canceled, and no claims are added; as a result, claims 1-3, 5-9, 11-18, and 20-27 remain pending in this application.

#### **§101 Rejection of the Claims**

Claims 1-3, 5-7, 14-18, 21-22, 26 and 27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 1 is amended to clarify that the method is a computer-implemented method and that certain operations are performed by at least a communication module, by an approved payment options generator, and by a selection module. It is submitted that the rejection has been overcome and it is respectfully requested that the rejection of claims 1-3, 5-7, and 26-27 be withdrawn.

Claim 14 is amended to clarify that the method is a computer-implemented method and that the operations of providing and requesting are performed via network equipment. It is submitted that the rejection has been overcome and it is respectfully requested that the rejection of claims 14-15 be withdrawn.

Claim 16 is amended as suggested in the Office action. It is submitted that the rejection has been overcome and it is respectfully requested that the rejection of claims 14-18 and 21-22 be withdrawn.

#### **§112 Rejection of the Claims**

Claims 5 and 12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5 and 12 are amended. It is submitted that the rejection has been overcome and it is respectfully requested that the rejection be withdrawn.

§102 Rejection of the Claims

Claims 1, 5-9, 12-14, 16, 20-24, 26-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bahreman (U.S. 6,061,665).

Bahreman is directed at a system that facilitates coupling of a plurality of clients to one or more merchants utilizing a network to conduct commerce over the network. (Bahreman, Abstract.) Bahreman explains the following.

When a client initiates a connection with a merchant, the merchant responds to the request for connection by transmitting one or more messages back to the client to determine a mutually acceptable payment processing method. This process entails a negotiation to determine a suitable payment instrument, a payment protocol and standard message formats for conducting the electronic commerce. The payment protocol comprises a message format, a protocol associated with the message format and a weight associated with each of the items associated with the payment processing methods. The weight is provided by both the client and the merchant to facilitate dynamic negotiation of a mutually acceptable method for processing payments. The negotiation results in the exchange of standard message formats that the client and the merchant are equipped to process efficiently and securely.

(Bahreman, 10: 43-62.)

The Office action relies on the description in Bahreman at 10: 43-62 (provided above) to show all features of claim 1. The relevant portion from the Office action that provides matching of the elements of claim 1 to the specific parts of Bahreman at 10: 43-62 is reproduced below.

**As to claim 1, Bahreman shows:**

**A method comprising:**

**receiving consumer information (weighting of payment methods) associated with a consumer (Client) (Column 10, lines 43-62);**

**identifying at least one approved payment option from a plurality of payment options (one or more messages corresponding to payment protocols, Id.)**

**utilizing the consumer information, the at least one payment option being valid for the consumer (mutually acceptable, Id.);**

**generating a list of approved payment options (comprising options "the client and the merchant are equipped to process efficiently and securely" Id.), the list including the at least one approved payment option (the approved option is picked from the list);**

**communicating the at least one approved payment option to the consumer for selection by the consumer (the list is communicated to the client, Id.); and**

**requesting that the consumer selects a payment option from the list (both the client, or consumer, and the merchant pick, through a weighting, a payment option or multiple payment options they prefer. Id.).**

(Detailed action, page 5.)

As shown above, Office action states that the weighting of payment methods correspond to "receiving consumer information associated with a consumer" recited in claim 1. As is evident from the passage reproduced above, the weight is associated with items of different payment processing methods and may be provided by both the client and the merchant. The weights in Bahreman serve to facilitate dynamic negotiation of a mutually acceptable method for processing payments. The weights, therefore, while may be provided by a client in Bahreman,

are associated with the items associated with the payment processing methods, but not with the client. Therefore, Bahreman fails to disclose or suggest "receiving consumer information associated with a consumer" recited in claim 1.

The Office action states that "identifying at least one approved payment option from a plurality of payment options utilizing the consumer information, the at least one payment option being valid for the consumer" recited in claim 1 is disclosed in Bahreman by references to messages corresponding to payment protocols. Applicants understand that what is meant by messages "corresponding" to payment protocols is the messages used to carry payment-related information and instructions between the parties. (See Bahreman, 13: 17-20.) The terms "payment protocol," "payment methods," and "payment capability," have a distinct meaning, as shown in Bahreman at 12:61 - 13: 23. It is submitted that a payment protocol is distinct from a payment option and therefore a "payment protocol" recited in Bahreman does not read on a "payment option" in general or on "an approved payment option," recited in claim 1, in particular. Furthermore, references to messages corresponding to payment protocols cannot be interpreted as disclosing the operation of identifying, from multiple payment option, an option that is valid for the consumer. It is submitted that negotiation between a client and a merchant of a mutually acceptable method for processing payments, is a process that is distinct from the operation of "identifying at least one approved payment option from a plurality of payment options utilizing the consumer information, the at least one payment option being valid for the consumer," as recited in claim 1.

The Office action states that "generating a list of approved payment options, the list including the at least one approved payment option" recited in claim 1 is disclosed by the statement in Bahreman that the negotiation results in the exchange of standard message formats that the client and the merchant are equipped to process efficiently and securely. It is submitted that an ability to process the message formats in an efficient and secure manner is distinct and unrelated to approved payment options. Furthermore, Bahreman makes no mention of generating a list in general or of generating a list of approved payment options in particular. The Office action refers to the approved option being picked from the list, while Brennan does not discuss any generated lists of approved payment options or an operation of picking from such

list. Therefore, Bahreman fails to disclose or suggest "generating a list of approved payment options, the list including the at least one approved payment option " recited in claim 1.

The Office action states that "communicating the at least one approved payment option to the consumer for selection by the consumer" recited in claim 1 is disclosed as the list in Bahreman is being communicated to the client. While the Office action refers to the list, Bahreman, as explained above, does not refer to a list of approved payment options, or to an operation of communicating of such list to the consumer, and even less so to communicating such a list for selection by a consumer. Therefore, Bahreman fails to disclose or suggest "communicating the at least one approved payment option to the consumer for selection by the consumer" recited in claim 1.

The Office action states Bahreman reads on "requesting that the consumer selects a payment option from the list" by stating that Bahreman, at 10: 43-62 refers to the client and the merchant picking their respective preferred payment option through weighting. It is submitted that an operation of indicating of a payment option preference is distinct from an operation of requesting that the consumer selects an option from a list that was generated to include approved payment options and communicated to the consumer. Furthermore, while a weight in Baherman is provided by both the client and the merchant to facilitate dynamic negotiation of a mutually acceptable method for processing payments, there is no mention in Baherman that the weights are in any way used in the context of picking from a list. Thus, Bahreman fails to disclose or suggest "requesting that the consumer selects a payment option from the list" recited in claim 1.

Because Bahreman fails to disclose or suggest the features of claim 1, claim 1 and its dependent claims are patentable and should be allowed.

Claim 8 recites modules configured to receive consumer information, generate a list of approved payment options, and present the consumer with an option to select a payment option from the list of at least one approved payment options respectively. As explained above, Bahreman fails to disclose or suggest these features. Therefore, claim 8 and its dependent claims are patentable in view of Bahreman for at least the reasons articulated above.

Claim 14 recites presenting to the consumer a list of payment options including at least one approved payment option and requesting that the consumer selects an approved payment option from the list. As explained above, Bahreman fails to disclose or suggest these features. Therefore, claim 14 and its dependent claim are patentable in view of Bahreman for at least the reasons articulated above.

Claim 16 recites instructions to communicate the at least one approved payment option to the consumer for the selection by the consumer and to request that the customer selects an approved payment option from a list including the at least one approved payment option identified based on the consumer information. As explained above, Bahreman fails to disclose or suggest these features. Therefore, claim 16 and its dependent claim are patentable in view of Bahreman for at least the reasons articulated above.

§103 Rejection of the Claims

Claims 3, 11, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bahreman in view of Dykstra (U.S. 5,611,052).

Claim 3 includes the features of claim 1 by virtue of being dependent on claim 1. As discussed above, Bahreman fails to disclose or suggest the features of claim 1. Dykstra, directed at an apparatus and method for automatic credit evaluation and loan processing (Dykstra, abstract, whether considered separately or in combination with Bahreman, also fails to disclose or suggest these features. Therefore, claim 3 is patentable in view of the Bahreman Dykstra combination and should be allowed.

Claim 11 includes the features of claim 8 by virtue of being dependent on claim 8. As discussed above, Bahreman fails to disclose or suggest all features of claim 8. Dykstra also fails to disclose or suggest these features. Therefore, claim 11 is patentable in view of the Bahreman Dykstra combination and should be allowed.

Claim 18 includes the features of claim 16 by virtue of being dependent on claim 16. As discussed above, Bahreman fails to disclose or suggest all features of claim 16. Dykstra also

fails to disclose or suggest these features. Therefore, claim 18 is patentable in view of the Bahreman Dykstra combination and should be allowed.

Claims 2, 15, 17 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bahreman.

Claims 2, 15, and 17 and 25 include the features of claims 1, 8, and 16 respectively, by virtue of being dependent on those claims respectively. As explained above, Bahreman fails to disclose or suggest all features of claims 1, 8, and 16. therefore, claims 2, 15, and 17 and 25 are patentable in view of Bahreman and should be allowed.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 25th day of September, 2008.

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